

REMARKS

New claims 118-120 are added. The new claims are supported by the originally-filed application by exemplary embodiments of the invention disclosed at, for example, first paragraph of page 10. Reconsideration of the application in view of the amendments and the remarks to follow is requested.

Claims 110 and 112 stand rejected under 35 U.S.C. §102(b) as being anticipated by Neu, 5,839,337. Claims 22, 92-93, 101-106, 109, and 115 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Neu in view of Patadia et al., 6,146,504. Claims 31-34 and 100 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Neu in view of Patadia et al. And further in view of Applicant's Admitted Prior Art. Claim 111 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Neu.

Regarding the obviousness rejection against claim 22 based on the combination of Neu and Patadia, claim 22 is amended to recite a plurality of blocks over a panel, the plurality of blocks configured to form a recessed portion over an uppermost surface of the panel, the recessed portion terminating at the uppermost surface of the panel. The amended language is supported by exemplary embodiments of the invention disclosed at, for example, Fig. 3 of the originally-filed application.

Neu teaches cavities 63 are formed to extend entirely through a pallet 62 (cols. 5-6 and Figs. 4-5 of Neu). The Examiner relies on Neu's teaching to cavities 63 and pallet 62 to allegedly teach the recited recessed portion and panel, respectively, of claim 22 (pg. 2 of paper no. 06252004). Neu further teaches crossing blade grooves 64 and 65 are formed

in the surface of pallet 62 proximate the cavities 63 which leaves surface sections of pallet 62 adjacent cavities 63 (cols. 5-6 and Figs. 4-5 of Neu). The Examiner points to some of these surface sections defined by crossing blade grooves 64 and 65 to allegedly teach the recited blocks of claim 22 (pg. 2 of paper no. 06252004). Neu further teaches that the purpose for cavities 63 to extend entirely through pallet 62 (and alleged blocks) is to allow receipt of suction cups 80 to project from the bottom of pallet 62 through cavities 63 to engage circuit devices 3 received over the top of pallet 62 wherein circuit devices 3 are secured to pallet 62 during processing (col. 6 through col. 7, line 20). Accordingly, Neu does not teach or suggest the **recessed portion terminating at the uppermost surface of the panel** since cavities 63 are formed entirely through pallet 62.

Moreover, no reasonable argument for modifying the Neu invention can be stated to teach this positively recited limitation of claim 22. That is, modifying the cavities 63 to **terminate at the uppermost surface of the pallet** would destroy the function of the Neu invention to have suction cups 80 extend through cavities 63 to secure devices 3, and such destructive modification of Neu is contrary to Federal Circuit law. The Examiner is respectfully reminded that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. MPEP §2143.01 (8th ed. revision no. 2) *citing to In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Therefore, no obviousness rejection would be appropriate based on modifying the Neu invention to teach the recessed portion terminating at the uppermost surface of the panel as positively recited

by claim 22. Since the combination of art fails to teach or suggest the positively recited limitation of claim 22, singularly or in any combination, claim 22 is allowable.

Claims 31-34, 92-93, 100-106, 109 and 118 depend from independent claim 22, and therefore, are allowable for the reasons discussed above with respect to the independent claim, as well as for their own recited features which are not shown or taught by the art of record.

Regarding the anticipation rejection and obviousness rejection against claim 110 based on Neu, claim 110 is amended to recite a plurality of blocks formed as one piece with the panel and extending upward from the uppermost surface of the panel thereby creating a recessed portion over the panel, an entirety of the recessed portion is directly over the uppermost surface of the panel. The amended language is supported by exemplary embodiments of the invention disclosed at, for example, Fig. 3 of the originally-filed application.

Neu teaches cavities 63 are formed to extend entirely through a pallet 62 to allow receipt of suction cups 80 to project from the bottom of pallet 62 through cavities 63 to engage circuit devices 3 for securing circuit devices 3 to pallet 62 (col. 6 through col. 7, line 20). Accordingly, it is inconceivable that Neu teaches or suggests an entirety of the recessed portion is directly over the uppermost surface of the panel since cavities 63 are formed entirely through pallet 62.

Moreover, no reasonable argument for modifying the Neu device can be stated to teach this positively recited limitation of claim 110. That is, modifying the Neu invention to

have an entirety of cavities 63 to be directly over the uppermost surface of pallet 62 would destroy the function of the Neu invention to have suction cups 80 extend through cavities 63 to secure devices 3. As stated previously, such destructive modification of Neu is contrary to Federal Circuit law (if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification MPEP §2143.01 (8th ed. revision no. 2) *citing to In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). Therefore, no obviousness rejection would be appropriate based on modifying the Neu invention to teach the positively recited limitation of claim 110. Since the combination of art fails to teach or suggest the positively recited limitation of claim 110, singularly or in any combination, claim 110 is allowable.

Claims 111-112 and 119 depend from independent claim 110, and therefore, are allowable for the reasons discussed above with respect to the independent claim, as well as for their own recited features which are not shown or taught by the art of record.

Regarding the obviousness rejection of claim 115 based on the combination of Neu and Patadia, claim 115 is amended to recite a plurality of ribs comprises only two ribs over a panel. The amended language is supported by exemplary embodiments of the invention disclosed at, for example, Fig. 3 of the originally-filed application.

Neu teaches crossing blade grooves 64 and 65 are formed in the surface of pallet 62 proximate cavities 63 which leaves surface sections formed in pallet 62. The Examiner alleges the surface sections formed by crossing blade grooves 64 and 65 teaches the

recited ribs of claim 115 (pgs. 2-3 of paper no. 06252004). However, Neu teaches pallet 62 has at least 20 surface sections (ribs) (Figs. 4-5). Accordingly, it is inconceivable that Neu teaches or suggests a plurality of ribs comprises only two ribs over the panel. Moreover, no reasonable argument for modifying the Neu device can be stated to teach this positively recited limitation of claim 115 because modifying the pallet 62 of Neu to have only two ribs would require additionally processing to the pallet 62 without providing any additional benefit. That is, removing the surface sections formed in pallet 62 would not enhance the support of circuit devices 3. Consequently, without any benefit for modifying the Neu device, no desirability can be stated to modify the Neu device as recited in claim 115. The Examiner is respectfully reminded that, “the initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done.” MPEP §2142 (8th Ed., revision no. 2) (emphasis added). Pursuant to this authority, no obviousness rejection would be appropriate based on modifying the Neu invention to teach the positively recited by claim 115. Since the combination of art fails to teach or suggest the positively recited limitation of claim 115, singularly or in any combination, claim 115 is allowable.

Claim 120 depends from independent claim 115, and therefore, is allowable for the reasons discussed above with respect to the independent claim, as well as for its own recited features which are not shown or taught by the art of record.

This application is now believed to be in immediate condition for allowance, and action to that end is respectfully requested. If the Examiner’s next anticipated action is to

be anything other than a Notice of Allowance, the undersigned respectfully requests a telephone interview prior to issuance of any such subsequent action.

Respectfully submitted,

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